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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,573	02/08/2002	Lone Jeppesen	5698.230-US	2711

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NOVO NORDISK PHARMACEUTICALS, INC  
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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/076,573

Applicant(s)

JEPPESSEN ET AL.

Examiner

Brenda Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,7,17,45-47,54 and 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,17,45-47,54 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/419,761.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 1, 2, 7, 17, 45-47, 54 and 55 are pending in the application.

This action is in response to applicants' amendment filed August 5, 2004. Claim 54 has been amended.

#### *Change of Examiner*

Note the change of Examiner in the present application. The Art Unit number (1624) remains the same.

#### *Response to Amendment*

In view of the amendments and arguments in the response of August 5, 2004, all the rejections of record have been overcome. However, upon further search and review, the **finality of the previous office action is withdrawn** and the new grounds of rejection below are seen necessary.

#### *Priority*

1. The applicants have indicated in the first line of the specification that this application is as follows:

This application is a divisional application of application serial no. 09/419,761 tiled October 19, 1999, **now allowed**, which claims priority under **35 U.S.C. 119 of Danish application PA 1998 01352 tiled October 21, 1998**, and of U.S. Provisional application 60/105,912 tiled October 28, 1998, the contents of which are fully incorporated herein by reference.

The first line of the specification must indicate any applications which were filed under 35 U.S.C. §§ 119(e) or 120. However, any foreign priority document, i.e. PA 1998 01352 should not be cited in this paragraph.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claims 1, 2, 7, 17, 45-47, 54 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1, 2 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of  $R^1$ ,  $R^2$ ,  $R^3$ , and  $R^4$  where "optionally substituted with one or more halogen, perhalomethyl, hydroxyl, nitro or cyano" appears after the semicolon following the definition of the substituents on the amino within the definition of  $R^{11}$  and  $R^{12}$ . Clarification is required as to which moiety is substituted.
- b) Claims 1, 7 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of ring A which is optionally substituted with hydrogen.
- c) Claim 1 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of  $R^5$  and  $R^6$  where "optionally substituted with one or more halogen, perhalomethyl, hydroxyl, nitro or cyano"

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appears after the semicolon following aralkyl. Clarification is required as to which moiety is substituted.

d) Claim 1 (and claims dependent thereon) are vague and indefinite in that it is not known what is meant by the definition of  $R^7$  and  $R^8$  where "optionally substituted with one or more halogen, perhalomethyl, hydroxyl, nitro or cyano" appears after the semicolon following heteroaralkyl group. Clarification is required as to which moiety is substituted.

e) Claim 7 recites the limitation "cyano,  $C_{4-7}$ -alkenynyl, aryloxy, aralkyl, aralkoxy, heterocyclyl, heteroaryl, heteroaralkyl, heteroaryloxy, heteroaralkoxy, acyl, acyloxy, hydroxy $C_{1-7}$ -alkyl, amino, acylamino,  $C_{1-7}$ -alkylamino, arylamino, aralkylamino, amino $C_{1-7}$ -alkyl,  $C_{1-7}$ -alkoxy $C_{1-7}$ -alkyl, aryloxy $C_{1-7}$ -alkyl, aralkoxy $C_{1-7}$ -alkyl,  $C_{1-7}$ -alkylthio, thio $C_{1-7}$ -alkyl,  $C_{1-7}$ -alkoxycarbonylamino, aryloxycarbonylamino, aralkoxycarbonylamino,  $-COR^{11}$ , or  $-SO_2R^{12}$ , wherein  $R^{11}$  and  $R^{12}$  independently of each other are selected from hydroxy, perhalomethyl or amino optionally substituted with one or more  $C_{1-6}$ -alkyl, perhalomethyl or aryl; optionally substituted with one or more halogen, perhalomethyl, hydroxy or cyano" in the definition of the substituents on ring A. There is insufficient antecedent basis for this limitation in the claim.

f) Claim 45 is vague and indefinite in that it is not known what is meant by  $10^6$  in the 1<sup>st</sup>, 2<sup>nd</sup>, 3<sup>rd</sup>, 4<sup>th</sup>, 5<sup>th</sup>, 6<sup>th</sup>, 7<sup>th</sup>, 8<sup>th</sup>, 9<sup>th</sup>, 10<sup>th</sup> and 11<sup>th</sup> species.

g) Claim 45 is vague and indefinite in that it is not known what is meant by  $5^4$  in the 12<sup>th</sup>, 13<sup>th</sup>, 14<sup>th</sup>, 15<sup>th</sup>, 16<sup>th</sup>, 17<sup>th</sup>, 18<sup>th</sup>, 19<sup>th</sup>, 20<sup>th</sup>, 21<sup>st</sup>, 22<sup>nd</sup>, 23<sup>rd</sup> and 24<sup>th</sup> species.


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- h) Claim 46 is vague and indefinite in that it is not known what is meant by 10<sup>6</sup> in the 1<sup>st</sup> species.
- i) Claim 45 is vague and indefinite in that it is not known what is meant by 5<sup>4</sup> in the 2<sup>nd</sup> species.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brenda Coleman  
Primary Examiner Art Unit 1624  
August 25, 2004